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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|-------------------------|------------------|
| 10/602,691 | 06/20/2003 | Jean-Pierre Sommadossi | 06171.IDX 1007 CON1 | 1388 |
| 57263 | 7590 | 05/30/2006 | EXAMINER | |
| KING & SPALDING LLP 191 PEACHTREE STREET ATLANTA, GA 30303-1763 | | | MCINTOSH III, TRAVISS C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1623 | |
| DATE MAILED: 05/30/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,691

Applicant(s)

SOMMADOSSI ET AL.

Examiner

Traviss C. McIntosh

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 130-152 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 130-152 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/10/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The Examiner of the U.S. Patent application SN 10/602,691 has changed. In order to expedite the correlation of papers with the application please direct all future correspondence to the Technology Center 1600, Art Unit 1623, attn: Examiner Traviss McIntosh.

The Amendment filed March 10, 2006 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 130 and 138 have been amended.

Claims 144-152 have been added

Claims 1-129 have been canceled.

Remarks drawn to rejections of Office Action mailed November 7, 2005 include:

102(e) rejection: which has overcome by applicant's arguments and has been withdrawn.

103(a) rejection: which has overcome by applicant's arguments and has been withdrawn.

An action on the merits of claims 130-152 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office Action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 130-131 and 133-149 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,914,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering pyrimidine 2'-methyl-ribofuranosyl nucleosides. It is obvious that the instant application and the '054 patent are substantially overlapping.

Claims 130, 132-146, and 150-152 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 89-169 of copending Application No. 10/602,136. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of

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treating HCV by administering purine 2'-methyl-ribofuranosyl nucleosides. It is obvious that the instant application and the '136 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 130-131 and 133-149 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 89-177 of copending Application No. 10/602,142. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering pyrimidine 2'-methyl-ribofuranosyl nucleosides. It is obvious that the instant application and the '142 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 130-131 and 133-149 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 89-182 and 197 of copending Application No. 10/602,976. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering pyrimidine 2'-methyl-ribofuranosyl nucleosides. It is obvious that the instant application and the '976 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Traviss McIntosh
May 25, 2006


Shaojia A. Jiang
Supervisory Patent Examiner
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